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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/719,101	02/23/2001	Isabelle Rollat-Corvol	05725.0807	4969

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EXAMINER
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WANG, SHENGJUN

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 04/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<p align="center"><b>Office Action Summary</b></p>	<p>Application No.</p> <p>09/719,101</p>	<p>Applicant(s)</p> <p>ROLLAT-CORVOL ET AL.</p>	
	<p>Examiner</p> <p>Shengjun Wang</p>	<p>Art Unit</p> <p>1617</p>	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 January 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 38-106 is/are pending in the application.
- 4a) Of the above claim(s) 59,61-68,70-77,80-82 and 85-87 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 38-58,60,69,78,79,83,84,88-106 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                            | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

### DETAILED ACTION

Applicants' appeal brief filed January 7, 2004 have been entered and fully considered.

The finality is herein withdrawn in favor of the following action.

Note applicants made species elections with traverse in Paper No. 10. The claims have been examined insofar as they read on elected species. Claims 59, 61-68, 70-77, 80-82 and 85-87 are withdrawn from consideration as directed to non-elected species.

### *Double Patenting Rejections*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 38-58, 60, 69, 78, 79, 83, 84, 88-106 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-41 of U.S. Patent No. 6,346,234 in view of Lee. '234 claims a remodelable hair styling composition comprising at least the tacky polymer herein. See the claims. The claims do not expressly recite the second polymer herein, the fixing polymer.

However, Lee teaches acrylate-based copolymers to be used advantageously as water-soluble amphoteric polymer, such as octylacrylamide/acrylates/butylaminoethyl methacrylate

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copolymer in hair treating composition (see page 3, lines 30-37). The water soluble amphoteric polymer provides a very substantial hold, and provide aiding in removing the water-insoluble resin in a hair composition from the hair upon shampooing (pages 3, lines 5-14).

Therefore, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed the invention was made, to employ octylacrylamide/acrylates/butylaminoethyl methacrylate copolymer as additional polymer known to be useful in hair treating composition.

A person of ordinary skill in the art would have been motivated to employ octylacrylamide/acrylates/butylaminoethyl methacrylate copolymer as additional polymer known to be useful in hair treating composition because such polymer provide additional benefit to the hair composition.

***Claim Rejections 35 U.S.C. 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 38-43, 45-50, 69, 78,79,83, 84, 88-106 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims are directed to composition comprising polymers, which are solely defined by physical properties "tacky" ;  $T_g$ ,  $F_{max}$ , or  $E_{s(M/V)}$ . etc. However, the specification provide no written description as to what the structural characteristics

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of a polymer would be required to meet all the functional limitations herein. In view of the fact of lacking working examples, guidance, and direction, one of ordinary skill in the art would have reasonable doubt that applicants, at the time the application was filed, had actually possession of such polymers other than the particular commercially available polymers herein employed.

***Claim Rejections 35 U.S.C. 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 38-58, 60, 69, 78,79,83, 84, 88-106 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee et al (EP 0551,749, of record), in view of Miller et al. (WO 95/18191, IDS).

Lee teaches a hair treatment composition comprising a water-insoluble, water-dispersible polymeric resin and a water-soluble amphoteric polymer (see abstract, page 3, lines 6-50; and pages 7-8, claims 1-8). Most preferred water-insoluble polymeric resin includes polyesters functionalized with a sulpho group such as Eastman AQ polymers (see pages 3, lines 15-20). Acrylate-based copolymers to be used advantageously as water-soluble amphoteric polymer of the composition, such as octylacrylamide/acrylates/butylaminoethyl methacrylate copolymer in hair treating composition (see page 3, lines 30-37). The water soluble amphoteric polymer provides a very substantial hold, and provide aiding in removing the water-insoluble resin in a hair composition from the hair upon shampooing (pages 3, lines 5-14).

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6. Lee does not teach expressly the employment of branched sulfonic polyester herein with Tg less than 20 °C.

7. However, Miller et al. teaches the improved branched sulfonic polyester with lowed Tg. The low Tg provide advantage that the composition will not be brittle at low temperature, thus maintain its property. (see particularly, pages 16-18).

Therefore, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed the invention was made, to modify Lee's composition by using the branched sulfonic polyester as the water-dispersible resin.

A person of ordinary skill in the art would have been motivated to modify Lee's composition by using the branched sulfonic polyester as the water-dispersible resin because the branched sulfonic polyester will not become brittle or lost its property at low temperature.

### ***Response to the Arguments***

8. Applicant's arguments presented in the appeal brief have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shengjun Wang, Ph.D. whose telephone number is (571)272-0632. The examiner can normally be reached on Monday-Friday from 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on (571)272-0629. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9302.

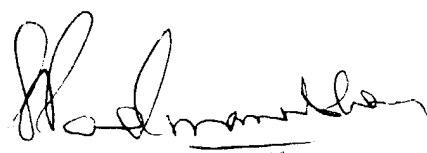
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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

S. ✓ **SHENGJUN WANG**  
**PRIMARY EXAMINER**

Shengjun Wang

April 17, 2004

  
**SREENI PADMANABHAN**  
**SUPERVISORY PATENT EXAMINER**